

REMARKS

Applicant amends claims 1, 9, 13, 20, 21, 24, 31, 32, 40, 41, 45, and 46. Claims 1-6, 9-36, and 40-47 remain pending and under examination.

Office Action

Applicant respectfully traverses the rejection of claims 1-6, 9-36, and 40-47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,536,659 (Hauser) in view of U.S. Patent Application Publication No. 2002/0178074 (Bloom).

35 U.S.C. § 103(a) Rejection of Claims 1-6, 9-36, and 40-47

Applicant respectfully traverses the rejections of claims 1-6, 9-36, and 40-47 under 35 U.S.C. § 103(a) as being obvious from Hauser in view of Bloom. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 calls for a combination including, for example, “creating a record in a second computer-implemented management system of the supplier for the return request, the record comprising the RAN,” and “splitting the record in the second database into a plurality of new records containing the unique identifier, based on the comparison.” Hauser fails to teach or suggest at least “creating a record in a second computer-implemented management system of the supplier for the return request, the record comprising the RAN,” and “splitting the record in the second database into a plurality of new records containing the unique identifier, based on the comparison,” as recited in claim 1, and similarly recited in independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41. (emphases added).

The Office Action alleged that element “Central return facility 100” of Hauser corresponds to the claimed “second computer-implemented management system,” as recited in claim 1. See Office Action, page 4. However, this is not correct.

Hauser discloses “a central return facility that has been created by Returns Online, Inc. to efficiently service returned merchandise for a plurality different merchants.” Hauser, column 3, lines 61-64. In operation, “before any merchandise will be accepted, merchant 14 must authorize the return and transmit the return data to Returns Online, Inc. for inclusion in its database.” Hauser, column 4, lines 2-5. (emphases added). Put another way, Hauser discloses that the central return facility database is not a management system belonging to any of the plurality of merchants or suppliers.

The Office Action admitted that Hauser does not disclose “splitting/dividing the record into a plurality of new records/files with the RAN/or identification number for the return product when less than all of the quantity is received,” but asserted that Bloom discloses this feature. Office Action, pages 5-6. Even if this assertion were correct, which Applicant does not concede, Bloom fails to cure the deficiencies of Hauser, discussed above. That is Bloom, also, fails to teach or suggest “creating a record in a second computer-implemented management system of the supplier for the return request, the record comprising the RAN,” recited in claim 1, and similarly recited in claims 9, 13, 20, 21, 24, 31, 32, 40, and 41.

Moreover, contrary to the Office Action allegations, Bloom also fails to teach or suggest “splitting the record in the second database into a plurality of new records containing the unique identifier, based on the comparison,” as recited in claim 1, and similarly recited in claims 9, 13, 20, 21, 24, 31, 32, 40, and 41.

Bloom discloses that “[i]n updating Order Detail records 1202 with Retailer Shipment Id’s, the program (312) can make adjustments to an Order Detail Record 1202 to partially fill an order” Bloom, ¶ [0099]. In these cases, “the program (312) can attempt to partially fill the order by creating a new Order Detail record 1202 and splitting the Order Detail Quantity across the new record 1202 and the existing record.” *Id.* (emphasis added). Bloom, however, discloses that the “Order data elements” included in “Order Detail table 1202” may include “Order Id, a SKU, a SKU Size, a Temperature Code, a Quantity, and Status.” *Id.* at ¶ [0077]. However, nothing in Bloom at paragraphs [0077, 0099, 0187], or in Bloom as a whole constitutes “splitting the record in the second database into a plurality of new records containing the unique

identifier, [RAN] based on the comparison," as recited in claim 1, and similarly recited in claims 9, 13, 20, 21, 24, 31, 32, 40, and 41. (emphasis added).

In view of the mischaracterization of the prior art set forth above, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed combinations and the prior art. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combinations obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 under 35 U.S.C. §103 as being obvious from Hauser in view of Bloom is thus improper and should be withdrawn.

Dependent claims 2-6, 10-12, 14-19, 22, 23, 25-30, 33-36, and 42-47 also should be allowable at least by virtue of their respective dependence from base claims 1, 9, 13, 20, 21, 24, 31, 32, 40, or 41, as well as because they recite additional features not taught or suggested by the combination of Hauser and Bloom. Applicant therefore respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-6, 9-36, and 40-47.

Conclusion

Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

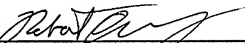
As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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